

REMARKS

Applicants respectfully request reconsideration of the instant application in the view of the following remarks. Claims 1-67 were previously pending in the instant application. Claims 20, 58 and 65 have been amended herein. Applicants submit that no new matter has been added by way of this amendment. Applicants explicitly reserve the right to add/pursue the claims as originally filed at a later date and/or in a continuation application. Applicants have amended the independent claims to expedite prosecution and to better capture disclosed embodiments of interest. Furthermore, Applicants submit that the claims as originally filed are patentably distinct from the cited references.

Claim Objections

The Examiner has objected to claims 20, 21 (depending from claim 20), 58 and 65 based on claim language informalities (see May 30, 2007 Office Action, p. 2, ¶ 2-4). Applicants have herein amended claims 20, 58 and 65 to remedy these informalities, as reflected in the amended listing of claims shown above. Accordingly, Applicants respectfully submit that the Examiner's objections to the claims have been overcome.

Rejections under 35 U.S.C. § 103

Claims 1-67 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Katz, et al. (US Patent No. 6,055,513) ("Katz"); Tasker ("Should We Send Bad Guys' Guns to the Contras?") ("Tasker"); Johnson ("Family Dollar on the Move") ("Johnson"); Dinell ("Businesses Taking a Hard Look at Air Travel as Fares Increase" ("Dinell"); an anonymous article ("Western Pacific Load Factor Reaches 55 Percent in September") ("Western Pacific"); De Lapa et al. (US Patent No. 5,822,735) ("De Lapa"); O'Brien, et al. (US

Patent No. 5,832,457) ("O'Brien"); Popyk ("The Mastercard Approach to Customer Service") ("Popyk"); Webber, et al. (US Patent No. 5,331,546) ("Webber"); Brown, et al. (US Patent Application No. 2006/0206393) ("Brown"); and Caldwell ("Hotels Pull a Switch") ("Caldwell"). Applicants respectfully traverse the Examiner's rejections and submit that the Examiner has not established a *prima facie* case of obviousness and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that the rejections in the May 30, 2007 Office Action fail to establish the relevant teachings of the prior art relied upon and differences in the claim over the applied references by not addressing every claim limitation. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added].

Independent claim 1 recites, *inter alia*:

1. A computer-implemented method for offering a travel product for sale, comprising:

receiving a preferred travel product record and
at least one alternate travel product record...

selecting at least one alternate travel product
based on the at least one received alternate travel product
record, wherein the at least one alternate travel product
provides a greater value to a seller if sold than the preferred
travel product and is related to the preferred travel product by
at least one travel product relation parameter....

Applicants submit that the cited references taken alone or in combination do not
discuss or render obvious at least a preferred travel product and an alternate travel product
wherein the alternate travel product provides a greater value to a seller and is related by at least
one travel product relation parameter.

The pending rejection acknowledges that "Katz does not disclose that . . . the
alternate travel product is related to the preferred travel product by at least one travel product
relation parameter." (see May 30, 2007 Office Action, p. 3, ¶ 2). However, the rejection
proceeds to allege that, "Tasker further teaches that an alternate travel product being upsold is
related to the preferred travel product by at least one travel product relation parameter (in that
both are hotel rooms, and presumably covering the same time period; 'SUITENING THE POT'
section)." (see May 30, 2007 Office Action, p. 3, ¶ 2). Applicants respectfully traverse this
argument and submit that Tasker does not discuss or render obvious at least "a travel product
relation parameter," as recited in independent claim 1. The pending rejection admits a
presumption of "a travel product relation parameter," and does not point to any specific aspect of
Tasker as allegedly discussing the claim element. Accordingly, Applicants respectfully request
reconsideration and withdrawal of this basis of the Examiner's rejection. Should the Examiner

disagree, Applicants respectfully request that the Examiner point to a specific excerpt of Tasker that allegedly discusses, "a travel product relation parameter," as recited in independent claim 1.

Furthermore, Applicants submit that the rejection in the May 20, 2007 Office Action has not established why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by not treating the claims as wholes. MPEP § 2141.02 (I) states, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (see, MPEP § 2141.02(I); original emphasis). MPEP § 2106 (II)(C), states *inter alia*: "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Applicants submit that the pending rejection concludes obviousness of the alleged differences of the claim elements over the cited art in isolation and not in respect to the claim elements recited in each claim taken as a whole. For example, the rejection alleges,

Katz discloses . . . selecting at least one alternate product based on the at least one alternate product record . . . Katz does not expressly disclose that the at least one alternate product record provides a greater value to a seller if sold than the preferred product, but this motivation is considered obvious, as well as implicit in the term "upsell" rather than "downsell." . . . Katz does not disclose that the products are travel products, and that the alternate travel product is related to the preferred travel product by at least one travel product relation parameter, but travel products are well known, as taught, for example, by Tasker; Tasker further teaches that an alternate travel product being upsold is related to the preferred travel product by at least one travel product relation parameter (in that both the hotel rooms and presumably covering the same time period; "SUITENING THE POT" section). [see May 20, 2007 Office Action, p. 3, ¶ 2]

Applicants object to the pending rejection's dissection of claim limitations in this manner. Applicants respectfully request that, if the Examiner maintains this rejection, the Examiner clarify the cited references in relation to the *claims and their limitations as wholes* as prescribed, *inter alia*, by MPEP § 2106 (II)(C) and 2141.02(I).

Furthermore, the Examiner acknowledges that Katz "does not expressly disclose that the at least one alternate product provides," but alleges that, "this motivation is considered obvious and implicit in the use of the term 'upsell'." (See, Office Action Page 3, ¶ 2). Applicants respectfully disagree and maintain the argument made in the March 12, 2007 response that Katz's "materially different" first and second products instead teach away from providing a relationship between the primary and alternate product in terms of value and at least one travel product relation parameter as recited in independent claim 1. Should the Examiner disagree and maintain the rejection, Applicants respectfully request that he explicitly address Applicant's argument.

Accordingly, Applicants submit that amended independent claim 1 is patentably distinct from the cited references. Furthermore, Applicants submit that none of the cited references, taken alone or in combination, remedy these deficiencies. Although Applicants have not explicitly addressed these references and their relation to the dependent claims, Applicants explicitly reserve the right to do so in a future response.

CONCLUSION

Therefore, Applicants submit that independent claim 1 is patentably distinct from the cited art of record for at least these reasons. Furthermore, Applicants submit that independent claims 29, 33, 35, 39-51, 61-63 and 67 are also patentably distinct from the

cited art of record for at least similar reasons. Applicants submit that claims 2-28, 30-32, 34, 36-38, 52-60 and 64-66, which are directly or indirectly dependent on independent claims independent claims 29, 33, 39-51, 61-63 respectively, are also patentably distinct from the cited art of record for at least similar reasons. Therefore, Applicants respectfully request the rejection of claims 1-67 be withdrawn and submit that each of the pending claims, are in condition for allowance.

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17200-079US1. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17200-079US1.

Respectfully submitted,
CHADBOURNE & PARKE, L.L.P.

Dated: June 20, 2008

By: /Walter G. Hanchuk/
Walter G. Hanchuk
Registration No. 35,179

Correspondence Address:

CHADBOURNE & PARKE, L.L.P.
30 Rockefeller Plaza
New York, NY 10112
212-408-5100 Telephone
212-541-5369 Facsimile